

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

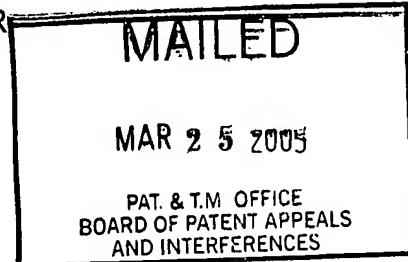
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MICHELLE BAKER

Appeal No. 2004-2338
Application No. 09/209,162

ON BRIEF



Before LEVY, BLANKENSHIP, and MACDONALD, ***Administrative Patent Judges***.

MACDONALD, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-24 and 26-27. Claim 25 has been canceled.¹

¹ The Abstract currently in the file is from a different application than the application on appeal. Markings on the Abstract indicate that this error occurred after filing and through no fault of Appellant. We recommend that the Examiner remove the erroneous Abstract and replace it with a copy from the scanned record made at the time of filing. We have checked and such copy is available via the Image File Wrapper system at the Examiner's desktop.

Invention

Appellant's invention relates to an electronic mail software system that includes a main email component and a number of installable components, which communicate bidirectionally with the email component. The installable components include authoring/reading components as well as at least one mailbox browser/editor component. The main email component provides an underlying graphical user interface (GUI) for functions directly associated with the storage and transfer of electronic mail messages. In particular, the main email component provides menu items, which allow the user to SEND, READ, REPLY, FORWARD, DELETE, SAVE, PRINT, for example. The main email program also handles all data bundling and unbundling that may be required to transform a message created by an authoring component into a fully MIME compliant message. In addition, the main email component includes "hooks" (an application programming interface or API) for the attachment of the installable components. The authoring/reading components each provide functionality, which is particular to the type of document the component is designed to create/display. For example, a text document authoring component includes word processing functionality such as font selection, margin setting, etc. A painting/drawing authoring component includes tools for line drawing, polygon creation, paint brush, paint can, eraser, etc. A spreadsheet authoring component displays a grid and includes formula creation tools as well as formatting tools. A database authoring tool includes tools for creating fields and

records, for sorting and searching, for generating reports, etc. A photo editor authoring component includes various imaging editing tools including cropping tools, dodging and burning tools, filters, etc. A presentation authoring component includes tools for creating slides and slide shows. The authoring components act like applications embedded within the email program and allow specific types of documents such as spreadsheets, graphics, databases, etc. to be created from within the email program and emailed directly. Appellant's specification at page 7, line 7, through page 8, line 17.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. An electronic mail client, comprising:
 - a) a plurality of authoring and reading components, a first of said plurality of authoring components for creating a representation of a document including an other than text portion and for creating the other than text portion of the document;
 - b) encoding means for automatically encoding said representation created with said authoring components into an Internet-compatible email message; and
 - c) decoding means for automatically decoding said representation encoded by said encoding means.

References

The references relied on by the Examiner are as follows:

Hong et al. (Hong)	5,710,883	Jan. 20, 1998
Wolf et al. (Wolf)	5,818,447	Oct. 6, 1998
Bradshaw et al. (Bradshaw)	6,065,056	May 16, 2000 (Filed Aug. 13, 1998)

Rejections At Issue

Claims 1-4, 8-11, 20-22, and 26-27 stand rejected under 35 U.S.C. § 102 as being anticipated by Wolf.

Claim 12 stands rejected under 35 U.S.C. § 103 as being obvious over Wolf.

Claims 13-16 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wolf and Bradshaw.

Claims 5-7 and 23-24 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wolf and Hong.

Claims 17-19 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wolf, Bradshaw, and Hong.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.²

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1-4, 8-9, and 11 under 35 U.S.C. § 102; we affirm the Examiner's rejection of claims 5-7 and 12 under 35 U.S.C. § 103; we reverse the Examiner's rejection of claims 10,

² Appellant filed an appeal brief on January 23, 2004. Appellant filed a reply brief on May 27, 2004. The Examiner mailed an Examiner's Answer on April 7, 2004.

20-22, and 26-27 under 35 U.S.C. § 102; and we reverse the Examiner's rejection of claims 13-19 and 23-24 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellant has indicated that for purposes of this appeal, the claims stand or fall together in eighteen groupings. See page 5 of the brief. Furthermore, Appellant argues each group of claims separately and explains why the claims of each group are believed to be separately patentable. See pages 6-25 of the brief and pages 1-4 of the reply brief. Appellant has fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellant's claims as standing or falling together in the eighteen groups designated by Appellant.

a) *Whether the Rejections of Claim 1 Under 35 U.S.C. § 102 and claims 5-7 under 35 U.S.C. § 103 are proper?*

It is our view, after consideration of the record before us, that the disclosure of Wolf does fully meet the invention as recited in claim 1. Further, it is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 5-7. Accordingly, we affirm the rejections of claims 1 and 5-7.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074,

5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. See also *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellant argues at pages 7-8 of the brief that a "separate program" is not a component. Appellant also argues at page 8, that editing borders, shading, and tables is merely text authoring and is not "creating the other than text portion of a document." We find Appellant's arguments unpersuasive.

To determine whether claim 1 is anticipated by the reference, we must first determine the scope of the claim. Appellant's specification shows a system with numerous authoring components at pages 7-9. Appellant argues that "component" should be narrowly defined so as to exclude separate programs. Note that Appellant's page 8 at lines 13-14, states that the authoring

components "act like applications embedded within the email program." We note that Appellant discloses at lines 18-19 of page 9 of the specification, that the mailbox/editor component is provided preferably as a separate component rather than as a part of the main email component so that the software may be easily customized and upgraded.

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." *Texas Digital Sys. Inc v. Telegenix Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 1058 (2003).

Upon our review of Appellant's specification, we fail to find any definition of the term "component" that is different from the ordinary meaning. We find the ordinary meaning of the term "component" is best found in the dictionary. We note that the definition most suitable for "component" is "a constituent element, as of a system".³ We note that the definition most suitable for "system" is "a

³ The American Heritage Dictionary, Second College Edition, 1982, page 302. Copy provided to Appellant.

group of interacting, interrelated, or interdependent elements forming a complex whole".⁴

We appreciate Appellant's position that "component" is only an embedded application rather than a separate program. However, we find that the claim language does not preclude reading on a separate program that "acts like an application embedded within the email program." The parts of Wolf's email editing system clearly fits the definition of a "component" as the system is a group of interacting, interrelated, or interdependent elements forming a complex whole. Further, as shown in Wolf's figure 4, the separate program acts like an application embedded within the email program. As to Appellant's statement that editing borders, shading, and tables is merely text authoring and is not "creating the other than text portion of a document", Appellant has failed to provide any argument in support of this position. On its face, these items are other than text. Therefore, without some argument to show the contrary, we see no basis to overturn the Examiner's rejection of claim 1.

As to claims 5-7, Appellant presents no further arguments and merely refers back to claim 1 discussed above.

Therefore, we will sustain the Examiner's rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

⁴ The American Heritage Dictionary, Second College Edition, 1982, page 1234. Copy provided to Appellant.

b) *Whether the Rejection of Claim 2 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Wolf does fully meet the invention as recited in claim 2. Accordingly, we affirm.

With respect to dependent claim 2, Appellant argues at pages 8-9 of the brief that Wolf does not teach "installable" as that term is fairly understood by those skilled in the art. Appellant then fails to state what they believe that definition to be. For this reason, we find that Appellant has failed to point out any error in the Examiner's *prima facie* case.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

c) *Whether the Rejection of Claim 3 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Wolf does fully meet the invention as recited in claim 3. Accordingly, we affirm.

With respect to dependent claim 3, Appellant argues at pages 9-11 of the brief that separate programs are not components. We have addressed this argument above with respect to claim 1 and find it unpersuasive.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

d) *Whether the Rejection of Claim 4 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Wolf does fully meet the invention as recited in claim 4.

Accordingly, we affirm.

With respect to dependent claim 4, Appellant argues at pages 11-12 of the brief that separate programs are not components. We have addressed this argument above with respect to claim 1 and find it unpersuasive.

Appellant also argues that “displaying” documents is not “authoring” an email. We find this argument unpersuasive. We find that in the context of the Wolf patent, an artisan would understand the teaching at column 23, lines 63-67, to include the editing (authoring) functions of the spreadsheet and publishing software on their respective documents. We note that the very next sentence in Wolf indicates that the purpose of the invention is “in place editing and viewing of documents.”

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 102.

e) *Whether the Rejection of Claim 8 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Wolf does fully meet the invention as recited in claim 8. Accordingly, we affirm.

With respect to dependent claim 8, Appellant repeats the arguments made with respect to claims 1 and 4. We find these arguments unpersuasive for the reasons discussed above.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

f) *Whether the Rejection of Claim 9 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Wolf does fully meet the invention as recited in claim 9. Accordingly, we affirm.

With respect to dependent claim 9, Appellant argues at page 13 of the brief, "Claim 9 is clearly different from claim 8 and thus has not been properly addressed by the Examiner." Appellant has failed to provide any argument in support of this position. Also, Appellant presents no argument as to why the specific limitations of claim 9 are not taught by Wolf. Pointing out the difference in language between claims is not an argument. Therefore, without some argument to show the contrary, we see no basis to overturn the Examiner's rejection of claim 9.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

g) *Whether the Rejection of Claim 10 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Wolf does not fully meet the invention as recited in claim 10. Accordingly, we reverse.

With respect to dependent claim 10, Appellant argues at page 14 of the brief that the bidirectionally limitation of claim 10 is not taught by Wolf. We agree, as the bidirectional feature referred to by the Examiner does not teach the claimed limitation of bi-directional communication between the authoring components and encoding/decoding means.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

h) *Whether the Rejection of Claim 11 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Wolf does fully meet the invention as recited in claim 11. Accordingly, we affirm.

With respect to dependent claim 11, Appellant argues at page 13 of the brief that claim 11 is clearly different from claim 10 and thus has not been properly addressed by the Examiner. Appellant has failed to provide any argument in support of this position. Also, Appellant presents no argument as to why the specific limitations of claim 11 are not taught by Wolf. Pointing out the

difference in language between claims is not an argument. Therefore, without some argument to show the contrary, we see no basis to overturn the Examiner's rejection of claim 11.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

i) Whether the Rejection of Claim 12 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claim 12. Accordingly, we affirm.

With respect to dependent claim 12, Appellant argues at page 21 of the brief that the spreadsheet program or desktop publishing program passage of Wolf is not relevant to claim 12. We disagree. We also note that the rejection states that Wolf teaches an authoring component comprising a "fully-featured word processing program" and that authoring of read-only documents "was well known at the time of the invention." The Examiner's taking of official notice as to the creating of read-only documents being well-known goes unchallenged by Appellant. We find that Appellant has failed to point out any error in the Examiner's *prima facie* case that it would be obvious to artisans to create read-only documents with any of these three authoring components.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

j) *Whether the Rejection of Claims 13 and 17-19 Under 35 U.S.C. § 103 is proper?*

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 13 and 17-19. Accordingly, we reverse.

With respect to independent claim 13, Appellant argues at page 22 of the brief that Bradshaw's mention of limiting student access is far from disclosing or suggesting an email authoring component which distinguishes between a teacher and a student. We agree. We see no determination of student versus teacher in Bradshaw, rather the reference determines supervisor versus non-supervisor. Claim 13 specifically requires that the authoring component include "means for determining whether the user is the student or the teacher."

With respect to dependent claims 17-19, we note that the Examiner has relied on the Hong reference solely to teach encoding. The Hong patent in combination with the Wolf and Bradshaw patents fails to cure the deficiencies of Wolf and Bradshaw noted above with respect to claim 13.

Therefore, we will not sustain the Examiner's rejections under 35 U.S.C. § 103.

k) *Whether the Rejection of Claim 14 Under 35 U.S.C. § 103 is proper?*

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 14. Accordingly, we reverse.

With respect to dependent claim 14, Appellant references the argument made with regard to claim 13. That argument is persuasive as discussed above. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

l) *Whether the Rejection of Claim 15 Under 35 U.S.C. § 103 is proper?*

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 15. Accordingly, we reverse.

With respect to dependent claim 15, Appellant's arguments at pages 23-24 of the brief are unpersuasive for the same reasons as discussed above with respect to claim 4. However, claim 15 depends from claim 13 and we have found the argument with regard to claim 13 to be persuasive as discussed above. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

m) Whether the Rejection of Claim 16 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 16. Accordingly, we reverse.

With respect to dependent claim 16, Appellant's arguments at pages 24-25 of the brief are unconvincing for the same reasons as discussed above with respect to claim 15. However, claim 16 depends from claim 13 and we have found the argument with regard to claim 13 to be persuasive as discussed above. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

n) Whether the Rejection of Claim 20 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Wolf does not fully meet the invention as recited in claim 20. Accordingly, we reverse.

With respect to independent claim 20, Appellant argues at page 15 of the brief that Wolf does not teach the linking step. The Examiner rebuts this by pointing out at page 16 of the answer that this argument was conceded by the Appellant, as it was not presented earlier. We have reviewed the record before us and do not find any teaching of "linking" as required in claim 20. Further, we

see no justification for the Examiner's position that the argument has been conceded by Appellant.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

o) Whether the Rejection of Claim 21 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Wolf does not fully meet the invention as recited in claim 21. Accordingly, we reverse.

With respect to independent claim 21, it depends from claim 20 and we will not sustain the Examiner's rejection under 35 U.S.C. § 102 for the reasons given above.

p) Whether the Rejection of Claims 22 Under 35 U.S.C. § 102 and Claims 23-24 Under 35 U.S.C. § 103 are is proper?

It is our view, after consideration of the record before us, that the disclosure of Wolf does not fully meet the invention as recited in claim 22. Accordingly, we reverse. Further, it is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 23-24. Accordingly, we reverse.

With respect to dependent claims 22-24, they depend from claim 20 and we will not sustain the Examiner's rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 for the reasons given above with respect to claim 20.

q) *Whether the Rejection of Claim 26 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Wolf does not fully meet the invention as recited in claim 26. Accordingly, we reverse.

With respect to independent claim 26, Appellant argues at page 18 of the brief that Wolf does not teach encoding with a message type identifier. The Examiner rebuts this by pointing out at page 17 of the answer that this argument was conceded by the Appellant, as it was not presented earlier. We have reviewed the record before us and do not find any teaching of encoding with a message type identifier as required in claim 26. Further, we see no justification for the Examiner's position that the argument has been conceded by Appellant.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

r) Whether the Rejection of Claim 27 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Wolf does not fully meet the invention as recited in claim 27. Accordingly, we reverse.

With respect to independent claim 27, Appellant argues at page 16 of the brief that Wolf does not teach automatically opening documents using the needed reading component. The Examiner rebuts this by pointing out at pages 16-17 of the answer that this argument was conceded by the Appellant, as it was not presented earlier. We have reviewed the record before us and do not find any teaching of automatically opening documents using the needed reading component as required in claim 27. Further, we see no justification for the Examiner's position that the argument has been conceded by Appellant.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claims 1-4, 8-9, and 11; we have sustained the rejection under 35 U.S.C. § 103 of claims 5-7 and 12; we have not sustained the rejection under 35 U.S.C. § 102 of claims 10, 20-22, and 26-27; and we have not sustained the rejection under 35 U.S.C. § 103 of claims 13-19 and 23-24.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

Stuart S. Levy
STUART S. LEVY)
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